

REMARKS

Claims 1 – 25 are pending in the case, but were examined and rejected by the Examiner in the Final Office Action mailed on December 31, 2002 (Paper No. 14). Upon review of the Final Office Action and pursuant to the telephonic interview with Examiner Hong on February 14, 2003, Applicants are submitting the following responsive remarks. In view of the responsive remarks, Applicants respectfully request the withdrawal of finality and reconsideration of the application in light of the following remarks.

Rejection Under 35 U.S.C. § 102

In paragraph 5 of the Final Office Action, the Examiner maintained the rejection of claims 1-9, 13-17, 21, and 23-25 under 35 U.S.C. § 102(e) as being anticipated by Gever et al. (US Patent No. 6,313,835 B1). The Examiner maintained the rejection of these claims under the arguments presented in the prior Office Action mailed July 3, 2002 (Paper No. 12). Applicants respectfully traverse.

Independent claim 1 recites "...displaying a marketing object container, said marketing object container including a location for receiving at least one marketing object to be presented in said marketing container to a user of an interactive medium; associating a marketing attribute with the marketing object container; and selecting at least one marketing object for being associated with the marketing object container." In Paper No. 12, the Examiner rejected independent claim 1 stating that Gever et al. discloses "displaying a marketing object container ("select template-Figure 9;), said marketing object container including a marketing location for receiving at least one marketing object to be presented in said marketing container to a user of an interactive medium ("...Internet banner prepared by double-click for inclusion in a web page

selects different advertisements...” – column 1, lines 52-61); associating a marketing attribute with the marketing object container (“user assigns conditional values or attributes of the animation sequence” – column 2, lines 26-35; see element 40-Figure 3, element 120-Figure 5; “user is able to change at least some of the attributes of the selected animation sequence, such as colors, borders, sounds, embedded pictures...” – column 2, lines 10-20); and selecting at least one marketing object for being associated with the marketing object container (“create web page component based on animation sequence...” – column 2, lines 27-31; “prepare interesting Web sites and Web advertisements in order to attract customers and maintain their standing...” – column 1, lines 21-24; e.g., animations 56-FIG. 3).” (Paragraph 9, page 4, Paper No. 12).

Applicants respectfully disagree in that Gever et al. does not anticipate the claimed invention and Applicants’ claim 1 is patentably distinguishable.

In order to properly establish a rejection under 35 U.S.C. §102(e), a reference must teach every aspect of the claimed invention, either explicitly or impliedly. *See* MPEP §706.02. A reference may be overcome by persuasively arguing that the claimed invention is patentably distinguishable over the cited prior art. *See* MPEP §706.02(b). Here, the Examiner has asserted (in Paper No. 12) that Gever et al. anticipates the claimed invention. However, Applicants submit that not every aspect of claim 1 is present. Among other aspects, Gever et al. does not disclose “...a marketing attribute....”

The disclosure in Gever et al. as cited by the Examiner is fundamentally different from the marketing attributes recited in claim 1. The Examiner rejected claim 1, stating that Gever et al. discloses “...user assigns conditional values or attributes of the animation sequence.”

(Paragraph 9, page 4, Paper No. 12). Read in light of the Applicants’ specification, “marketing attributes” in claim 1 are patentably distinct from “conditional values or attributes” as recited in

Gever et al. Marketing attributes include marketing campaigns and features in merchandise marketing, scheduling of objects to be displayed, behavior-driven targeting of marketing material to a user, and profile-driven targeting of the marketing material to a user. (Paragraph 1, page 16, Specification). Examples of marketing attributes include ad banners, catalog promotions, category dependent content, category lists, co-marketing campaigns, among others listed at pages 16-17 of the Applicants' specification. The Examiner's citation of conditional values or attributes of animation sequences in Gever et al. is patentably distinct from the claimed invention.

According to the Examiner, Gever et al. discloses that a "user is able to change at least some of the attributes of the selected animation sequence, such as colors, borders, sounds, embedded pictures...." (Column 2, lines 10-20). Marketing attributes, as recited in claim 1, are patentably distinguishable from "...colors, borders, sounds, embedded pictures" and other aspects directed to an animation sequence as disclosed in Gever et al. Similarly, Gever et al. refers to characteristics such as "...colors, texts, fonts, characters, borders, sounds, embedded pictures and models" to create one or more individualized Web page components. (Column 2, lines 10-20). However, marketing attributes of the claimed invention, when read in light of the Applicants' specification, make clear that "marketing attributes" are patentably distinguishable from the animation sequence characteristics in Gever et al., as discussed above.

As disclosed in the Applicants' specification, examples of marketing attributes include "marketing campaigns and features in merchandising marketing, scheduling of objects to be displayed, behavior-driven targeting of marketing material to a user, and profile-driven targeting of the marketing material to a user." (Page 16, Specification). The Applicants submit that a person having ordinary skill in the art at the time the invention was made would appreciate that

“marketing attribute” as recited in claim 1 and illustrated in the Applicants’ specification, is patentably distinct from a border, color or font. The color blue, for example, is not a marketing campaign or feature such as a daily promotion, content detail, cross sell, or up sell. (Pages 16-17, Specification). A person having ordinary skill in the art at the time the invention was made would readily understand that the characteristics recited in Gever et al. are patentably distinct from the “marketing attributes” of claim 1. Thus, claim 1 is patentably distinguishable and not anticipated by Gever et al.

The Applicants submit that the rejection under 35 U.S.C. §102 has been traversed and request a Notice of Allowance for claim 1. Further, claims 2-9 and 13-17 are allowable for at least the same reasons as claim 1 as they depend from claim 1. Claims 23 and 24 should also be allowable because these claims are directed to a system and computer product, respectively, for performing the method of claim 1, and thus are also allowable. Claims 23 and 24 are also allowable because they include the limitation of “...a marketing attribute,” which is allowable for the same reasons as those stated above for claim 1. In addition, claim 25 should be allowable for at least the same reasons as claims 1 and 24.

Rejection Under 35 U.S.C. § 103

In Paper No. 12, the Examiner rejected claims 12 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Gever et al. The Examiner also rejected claims 18 and 20 as being unpatentable over Gever et al. in view of Tobin (U.S. Patent No. 6,141,666). Further, claims 10-11 and 20 were rejected as being obvious over Gever et al. in view of Henson (U.S. Patent No. 6,167,383 B1). Finally, claim 22 was rejected as being unpatentable over Peckover (U.S. Patent

No. 6,119,101) in view of Gever et al. In the Final Office Action, the Examiner maintained the rejection of these claims, which Applicants respectfully traverse.

In order to establish a prima facie case of obviousness and properly reject claims under 35 U.S.C. §103(a), three basic criteria must be met: 1) there must be some suggestion or motivation to modify or combine the reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art references must teach or suggest all claim limitations. *See* MPEP §706.02(j). As for claims 12 and 19, these claims depend from claim 1. The Examiner has not rejected claim 1 under 35 U.S.C. §103(a). Further, as Gever et al. does not teach all of the limitations of claim 1, as discussed above, claim 1 is therefore not obvious in light of the cited reference. Therefore, as claim 1 is patentable and non-obvious, claims 12 and 19, for those reasons discussed above, are also in condition for allowance. As claims 12 and 19 depend from claim 1, they are allowable for the same reasons as those stated above for claim 1.

Of the three basic criteria presented above, the Examiner has failed to show that all claim limitations are present in Gever et al. *See* MPEP §706.02(j). Thus, Applicants have traversed the rejection of claims 12 and 19 and submit these claims are in condition for allowance. Further, pending claims 18 and 20 are also non-obvious in view of the cited combination of Gever et al. in view of Tobin. For similar reasons to those stated above for claims 12 and 19, claims 18 and 20 are also in condition for allowance.

As to the rejection of claims 10-11 and 20 as being obvious over Gever et al., in view of Henson, the Applicants respectfully disagree. As discussed above, Gever et al. fails to disclose all claim limitations of claim 1, from which claims 10-11 and 20 depend. Further, the Examiner concedes that Gever et al., with regard to claims 10-11 and 20, "...lacks an explicit recitation of associating a "cross-sell" and "up-sell" feature with its marketing objects." (Paragraph 33, page

13 of Paper No. 12). The Examiner's statement further reinforces the Applicants' position that Gever et al. does not disclose the marketing attribute of claim 1 and that "...attributes of the selected animation sequence, such as the colors, texts, fonts, characters, borders, sounds, embedded pictures and models" are clearly dissimilar. Again, Applicants submit that rejecting claims 10-11 and 20 is improper in that the basic criteria for establishing a prima facie case of obviousness have not been met. All claim limitations of the cited references, either individually or in combination, are not present. See MPEP §706.02(j). Thus, claims 10-11 and 20 are in condition for allowance. Applicants also disagree with the rejection of claim 22.

Maintaining the rejection from Paper No. 12, the Examiner rejected claim 22 under 35 U.S.C. § 103(a) as being unpatentable over Peckover in view of Gever et al. However, Applicants submit that claim 22 is also allowable for the reasons stated above for claims 12 and 19, 18 and 20, and 10-11 as the cited references fail to disclose all claim limitations. Specifically, Gever et al. fails to disclose "selecting a campaign to apply to the marketing object container." A "campaign," as used in claim 22 is not disclosed by either Gever et al. or Peckover. As neither reference, either individually or in combination fails to teach this aspect and there is neither suggestion nor motivation to combine the references to yield a marketing "campaign," claim 22 is not obvious.

As stated in the previous response (Paper No. 13), independent claim 22 recites "selecting a campaign." In Paper No. 12, the Examiner rejected claim 22 stating that "[U]ser selects market 564—FIG. 31A; Note the "market" described by Peckover meets the broadest reasonable interpretation of campaign, even though identical terminology was not employed." The Applicants respectfully disagree. "Market" does not read upon the claim limitation of "campaign" in claim 22.

“Market,” as described by Peckover is a place in which an advertisement is placed (i.e., “...the provider selects a Market 18 in which the advertisement will be placed.” - column 34, lines 26-29). The Examiner in his rejection of claim 22 incorrectly analogizes “Market” in Peckover to a “campaign” as recited in the claimed invention. Independent claim 22 refers to a “campaign” as a type of marketing attribute or feature. (Pages 16-18, Specification). In other words, where “market” refers to a “place” in which an advertisement is placed, “campaign” refers to a “marketing campaign or feature.” (Page 16-17, Specification). A marketing campaign or feature is not a place in which to place an advertisement. Thus, the comparison made by the Examiner is improper.

As defined by the Applicants’ specification, the claimed invention limitation of “campaign” is not disclosed by the “market” element of Peckover. Further, as neither Gever et al. nor Peckover discloses all claim limitations, the rejection of claim 22 under 35 U.S.C. §103(a) cannot stand. Thus, the Applicants submit that claim 22 is in condition for allowance.

Based on the foregoing remarks, Applicants believe that the rejections in the Final Office Action of December 31, 2002 are fully overcome and that the application is in condition for allowance. If the Examiner has any questions regarding the case, the Examiner is invited to contact Applicant's undersigned representative at the number given below.

Respectfully submitted,

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